



Attorney Docket No. 23439-030-402

Group Art Unit: Not yet assigned

Examiner: Not yet assigned

For: REMOTE VEHICLE EMISSIONS SENSING DEVICE WITH SINGLE
DETECTOR

Assistant Commissioner for Patents
Washington, D.C. 20231

**STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF
NON-SIGNING INVENTORS**

This is a statement of the facts relied upon to establish the diligent efforts to secure the execution of the Joint Declaration For Patent Application by the non-signing inventors for the above identified patent application. Also included is a statement of facts relied upon to show that this petition is necessary to preserve the rights of the parties and prevent irreparable damage.

The declarations and affidavits included with this statement are made by persons with first-hand knowledge of the facts recited therein.

Attached is the affidavit of **Niranjan Vescio** and sets forth facts pertaining to the necessity of this petition to preserve the rights of the parties and prevent irreparable damage.

Additional facts are set forth below.

I, Christopher Cuneo declare that:

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STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NON-SIGNING INVENTORS
U.S. Application Serial No. 09/840,080
Attorney Docket No. 23439-030-402

1. On information and belief, JOHN DIDOMENICO AND JAMES H. JOHNSON were employees of **Environmental Systems Corp.** or its predecessors in interest (referred to herein as **ESC**).
2. On information and belief, during their tenure at ESC, JOHN DIDOMENICO, AND JAMES H. JOHNSON developed the invention that is the subject of the present application.
3. A provisional patent application (serial no. **60/115,537**), from which the present application claims priority, was filed on **January 12, 2000**.
4. On information and belief, subsequent to **January 12, 2000**, JOHN DIDOMENICO terminated his employment with ESP and joined **SPX Corporation**, a direct competitor of **ESC**.
5. On information and belief SPX employs Mr. DiDomenico to develop products intended to compete with ESC products.
6. On information and belief, subsequent to **January 12, 2000**, JAMES H. JOHNSON terminated his employment with ESC.
7. On information and belief, MR. DIDOMENICO AND JAMES H. JOHNSON have refused, either explicitly or by conduct, to execute the Joint Declaration For Patent Application.
8. On information and belief, on January 23, 2001, Devin S. Morgan, an agent of the firm previously responsible for the prosecution of this application, sent a letter by

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- certified mail to the last known address for James H. Johnson. Copies of the letter, the envelope, and the certified mail receipt are attached.
9. On or about January 25, 2001 the above letter to Mr. Johnson was returned due to an expired forwarding order.
 10. On information and belief, in or about February 2000, John DiDomenico broke off correspondence with Kevin Dunleavy, an agent of the firm previously responsible for prosecution of this application.
 11. On or about September 21, 2000, I contacted John DiDomenico via electronic mail in order to renew discussions about executing the Joint Declaration For Patent Application.
 12. On September 21, 2000 John DiDomenico sent an electronic mail message indicating that he not be contacted at addresses associated with SPX (attached).
 13. In response to John DiDomenico's September 21, 2000 electronic mail, I attempted to contact John DiDomenico to establish an address at which he would receive correspondence. Mr. DiDomenico never supplied such an address.
 14. On information and belief, on January 23, 2001 Devin Morgan sent a letter to John DiDomenico via certified mail to Mr. DiDomenico's last known home address. Copies of the letter, receipt, and envelope are attached.
 15. On information and belief, the letter was returned on or about February 2001 with the envelope marked as "unclaimed."
 16. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and


STATEMENT OF FACTS SUPPORT OF FILING
ON BEHALF OF NON-SIGNING INVENTORS

U.S. Application Serial No. 09/840,080

Attorney Docket No. 23439-030-402

further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: November 13, 2001



Christopher Cuneo
Reg. No. 42,450

RES 56994v1

HUNTON WILLIAMS



January 23, 2001

Via Certified Mail

Mr. James H. Johnson
4401 W. Crestview Road
Tucson, AZ 85745

Dear Mr. Johnson;

I am an attorney working for Environmental Systems Products, Inc., the parent company of Envirotech Systems Corp. and other related entities. I am assisting ESP with various matters related to its patent portfolio. During your time as an employee of ESP's family of companies, you were involved in the invention of several new technologies for which ESP is seeking or has sought patent protection. ESP requests your continued assistance in securing its patent rights.

Specifically, ESP needs your assistance reviewing and executing various documents related to patent applications for technologies you assisted in pioneering. Please contact me at your earliest convenience so that we can make arrangements for you to review and execute the necessary documents.

Patent rights and the administrative procedures for securing patent rights are costly and time sensitive. Any delay on your part may generate additional expenses for ESP and could jeopardize the company's valuable patent rights. I understand that you are probably busy with other things, but please make every effort to respond to me as soon as possible. I remind you of your continuing duty, pursuant your former employment, to assist ESP in securing its patent rights.

Thank you for your time and assistance in this matter.

Sincerely,

Hunton & Williams

Devin S. Morgan

1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500
FAX 202 • 778 • 2201

DEVIN S. MORGAN
DIRECT DIAL: 202 • 955 • 1965
EMAIL: dmorgan@hunton.com

FILE NO. 47382 000060

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Sent to James H. Johnson	
Street & Number 4401 W. Crestview Rd	
Post Office, State, & ZIP Code Tucson, AZ 85745	
Postage	\$ 34
Certified Fee	1.90
Special Delivery Fee	
Restricted Delivery Fee	
Return Receipt Showing to Whom & Date Delivered	1.50
Return Receipt Showing to Whom, Date, & Addressee's Address	
TOTAL Postage & Fees	\$ 3.74
Postmark or Date 1/23/01	

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WASHINGTON, D.C. 20006-1109

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TO
SENDER

Mr. James H. Johnson
4401 W. Crestview Road
Tucson, AZ 85745

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From: John DiDomenico [mailto:jdidomen@spxateg.com]
Sent: Thursday, September 21, 2000 1:56 PM
To: Cuneo, Chris; CRendahl@spxateg.com
Cc: Gatto, Jim; Aksman, Stanislaus
Subject: Re: Envirotest Patent Applications

Please, do NOT sent me any communications for any reason to
any e-mail or
street address that belong to SPX Corporation.

John

HUNTON & WILLIAMS



January 23, 2001

Via Certified Mail

Mr. John DiDomenico
8810 E. Bear Paw Place
Tucson, AZ 85749

Dear Mr. DiDomenico;

We have previously contacted you with regard to various patent related matters for Environmental Systems Products, Envirotech Systems Corp, and other related entities (collectively "ESP"). Specifically, your assistance is needed reviewing and executing various documents related to patent applications for technologies you helped pioneer while employed with one or more ESP related entities.

We have requested your assistance with review and execution of documents related to each of the following applications: "REMOTE EMISSIONS SENSING SYSTEM WITH IMPROVED NO_x DETECTION," "VEHICULAR RUNNING LOSS DETECTION SYSTEM," "REMOTE EMISSIONS SENSING SYSTEM AND METHOD WITH A COMPOSITE BEAM OF IR AND UV RADIATION THAT IS NOT SPLIT FOR DETECTION," "REMOTE VEHICLE EMISSION SENSING DEVICE WITH SINGLE DETECTOR," "MULTILANE REMOTE SENSING DEVICE," and "EXHAUST OPACITY MEASURING DEVICE." However, you have been unresponsive to most of our correspondence. We have yet to receive the necessary documents from you in any of the above referenced cases.

Most recently, you expressed some concerns related to prior art for and commercialization of one or more inventions described in the applications listed above. Chris Cuneo contacted you via electronic mail on September 21, 2000 in an attempt to work with you to present the facts forming the basis of your concerns to the U.S. Patent and Trademark Office (PTO). Our hope was to amicably resolve your concerns, cite any necessary prior art to the PTO, and allow the legal scope of the patent applications to be determined by the PTO. You replied that you did not wish us to contact you at your place of business. However, you have refused to provide an alternate means of contacting you, as we requested. We are sending this letter to your residential address in hopes that you will be amenable to further communications through this channel.

In addition to renewing our prior requests, we request your assistance with an application for reissue of U.S. Patent No. 5,812,249, entitled "SPEED AND ACCELERATION

1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500
FAX 202 • 778 • 2201

DEVIN S. MORGAN
DIRECT DIAL: 202 • 955 • 1965
EMAIL: dmorgan@hunton.com

FILE NO: 47332.000060

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Mr. John DiDomenico

January 23, 2001

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MONITORING DEVICE USING VISIBLE LASER BEAMS. You are one of the inventors on this patent and previously executed a declaration and assignment relating to it. Because we are applying for a broadening reissue, a new declaration must be submitted. A copy of the issued patent, the reissue claims and the reissue declaration are enclosed for your review and signature. Please review the patent and claims, sign the declaration, and return it to me.

Patent rights and the administrative procedures for securing patent rights are costly and time sensitive. Any delay on your part may generate additional expenses for ESP and could jeopardize ESP's valuable patent rights. I understand that you may now have competing interests. I remind you of your continuing duty, pursuant your former employment, to assist ESP in securing its patent rights. As you may be aware, if you refuse to assist ESP, PTO rules provide a vehicle for protecting ESP's rights. We intend to take whatever steps are necessary on behalf of ESP to protect their rights. We continue to be willing to make every reasonable effort to resolve any issues you may have and seek a speedy resolution to this matter.

Please contact me at your earliest convenience so that we may work to a resolution of these matters. Thank you for your time and assistance.

Sincerely,

Hunton & Williams



Devin S. Morgan

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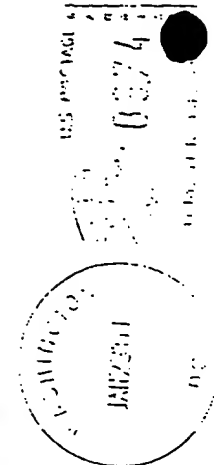
US Postal Service
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Sent to		John DiDomenico
Street & Number		8810 E. Bear Paw Pl.
Post Office, State, & ZIP Code		Tucson AZ 85749
Postage	\$.34
Certified Fee		1.90
Special Delivery Fee		
Restricted Delivery Fee		
Return Receipt Showing to Whom & Date Delivered		1.50
Return Receipt Showing to Whom, Date, & Addressee's Address		
TOTAL Postage & Fees	\$	
Postmark or Date		\$ 3.74

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HUNTON & WILLIAMS
1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

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MAIL

Mr. John DiDomenico
8810 E. Bear Paw Place
Tucson, AZ 85749

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TO Devin Morgan

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Declaration of Niranjan Vescio


I, Niranjan Vescio, hereby declare the following:

1. I am an employee of Envirotech Systems Corporation (ESC). My responsibilities include monitoring competitors.
2. On information and belief, John DiDomenico, and Craig S. Rendahl are employed by SPX Corporation (SPX) to develop products that directly compete with ESC products.
3. On information and belief, James H. Johnson was employed by MD LaserTech, LTD. (MD Laser) to develop products that compete with ESC products.
4. I have personally witnessed presentations, obtained promotional material and had discussions with other industry personnel that substantiate my belief that SPX and MD Laser are developing competing products.
5. At the 2000 CRC conference in San Diego, California, I personally witnessed Mr. Rendahl deliver a presentation in which he highlighted various aspects of SPX's plan to design, manufacture and market a remote sensing device to compete against ESP products.
6. At the 2001 CRC conference, I witnessed SPX present a poster that described progress made in the development of their remote sensing device. At that conference I witnessed Mr. John DiDomenico, as chief engineer for SPX, describe some of SPX's technical achievements. I also witnessed Dr. Glan Sachse, a NASA collaborator, elaborate on some of the technical aspects of SPX's products which are being developed to compete against ESP's remote sensing device.

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7. I have visited the SPX website page (<http://www.shareholder.com/spx/news/20000719-18037.cfm>) (copy attached) that announces SPX's license to use NASA technology to develop a remote sensing device which will compete against ESP products. This same announcement quotes Mr. Rendahl as saying "we expect to begin manufacturing a highly enhanced remote sensing device before the end of 2001."
8. I have visited the MD Laser website (<http://www.md-lasertech.com/profile.html>) (copy attached) that describes MD Laser's products that are designed to compete with ESP products.
9. I have obtained a promotional CD-ROM disk that describes SPX's interest in developing a remote sensing device that competes with ESP products.
10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: Aug. 1, 2001


Niranjana Vescio
Title: Technical Marketing Director

SPX Corporation

SPW \$116.25 +1.5 4:03 PM ET - Sep 3

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Press Releases

SPX Service Solutions to Adapt Nasa Satellite Technology to Monitor Vehicle Pollution

KALAMAZOO, MICHIGAN - JULY 19, 2000 – SPX Service Solutions, a unit of SPX Corporation (NYSE:SPW) today announced that it has received the exclusive license to use patented NASA technology for use in developing a new remote sensing device to monitor motor vehicle exhaust.

Cities and states may soon have a new high-tech tool in the battle against automotive air pollution, thanks to NASA satellite technology originally developed to track global greenhouse gases and the Earth's protective ozone layer. As envisioned, NASA's atmospheric remote sensing technology will be adapted to an autonomous roadside system to monitor motor vehicle emissions.

Cars and trucks will pass through a low-power light beam, without stopping or slowing down. Space-age sensor technology will instantly analyze vehicle exhaust pollutants important to local and state governments working to meet federally mandated air quality standards.

"Taking an accurate reading of several exhaust products as a car passes by is a formidable challenge. We want to take a measurement of all the gases of interest every one thousandth of a second over a period of a half-second. Fortunately, our newest remote sensing technology has that capability," said Glen Sachse, senior research scientist at NASA Langley Research Center, Hampton, VA. Sachse is one of six team members who invented the highly sensitive electro-optical system at the core of the technology.

"Remote testing of vehicle exhaust will provide governments around the world with a fast, efficient and low-cost method to identify and reduce motor vehicle air pollution and greenhouse gases, which account for approximately half of all air pollution," said Craig Rendahl, Remote Sensing business leader for SPX Service Solutions.

"With the number of vehicles on the road increasing every year, we believe there is a significant global market for technology of this nature," said Rendahl. "SPX will offer a basic unit which will be available at the end of 2000. With the help of NASA, we expect to begin manufacturing a highly enhanced remote sensing device before the end of 2001. This second-generation product will contain many other features, including the capability to test heavy-duty diesel vehicles."

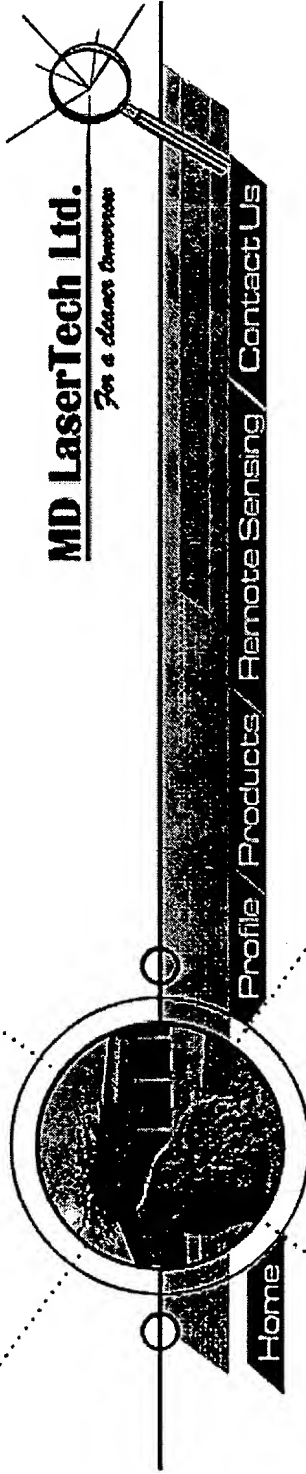
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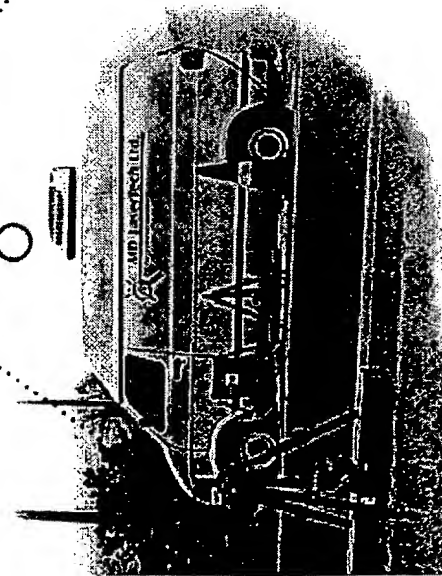
Remote Sensing Systems



MD LaserTech Ltd.

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our **Personnel**

Company Profile

MD LaserTech was founded in 1998 to provide high quality remote sensing services and technology to states and government agencies as a complement their vehicle emissions control programs.

Highly experienced remote sensing and emissions systems development personnel founded MD LaserTech. The team has many years experience in the development, deployment, manufacture and operation of vehicle emissions testing and remote sensing technology and equipment.

MD LaserTech offers the industry's most advanced remote sensing systems for 2-Gas, 4-Gas and diesel opacity emissions analysis. In addition to products for emissions applications, MD LaserTech also offers advanced remote sensing systems for speed limit enforcement.

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